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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/525,937
Filing Date: February 25, 2005
Appellant(s): BIESTER, KLAUS

David A. Rose
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 5, 2010 appealing from the Office action mailed March 12, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

German reference, DE 36 07 899 A1, Linzenkirc, October 1, 1987.

3998108	Vyskocil	12/1976

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 2, 14-16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Linzenkirc (DE 3 607 899).

Linzenkirc discloses a drive device, the operating element being actively connected with at least one driving motor (9,9') via a drive train (10,10'), and at least one transmission changing unit being arranged in the drive train for converting a revolution of the driving motor into a revolution of the operating element, and/or a revolution/linear motion converter being arranged for converting the revolution of the driving motor into a linear motion of the operating element, characterized in that the drive train comprises at least one essentially disk- or wheel-shaped revolution introducing device (12) actively connected with at least two drive shafts (11,11') rotated by separate driving motors.

2. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linzenkirc (DE 3 607 899) in view of Vyskocil (USP 3,998,108).

Linzenkirc does not disclose the gearing device having a worm, however the use of a worm gearing was well known in the art to obtain a desired speed reduction. For example, the prior art to Vyskocil discloses a worm gearing device for a valve arrangement. It would have been obvious to one of ordinary skill in the art to configure the gearing device of Linzenkirc with a worm arrangement, as taught

by Vyskocil, motivation being to provide a gear device having a predetermined speed reduction.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linzenkirc (DE 3 607 899).

Linzenkirc does not disclose the gearing device having a position sensor, however it was notoriously known in the art to provide means for determining a position of an actuator. Official Notice is taken with respect to providing a sensor on a driven member of an actuator for determining a position of the actuator output, since it was well known in the art.

(10) Response to Argument

(A) Linzenkirc

Applicant argues the Examiner did not indicate which portions(s) of Linzenkirc disclose the subject matter of the rejected claims. Further, applicant notes that the reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art (MPEP 706.02, p. 700-20). Finally, applicant acknowledges the option of seeking supervisory relief by way of a petition to have the examiner obtain and supply a translation.

Referring to the Final Rejection, section 2, Examiner clearly indicated the claimed features of the device by way of reference numerals. For example, the Final Rejection describes the driving motor (9,9'), the drive train (10,10'), and the two drive shafts (11,11'). A person experienced in prosecuting an application before the Office would know to reference the cited documents, including the Figures and English abstract, given the Examiners rejection which points out specific components by way of reference numerals. Further, it is noted applicant has not filed a petition to have the examiner obtain and supply a translation of the German Reference. Nevertheless, an English translation of Linzenkirc was filed on December 12, 2009. It is found by the Examiner that the combination of the English abstract, the Figures, and the International Search Report of Linzenkirc clearly teach each and every component of the claimed device.

(B) Claims 1, 2, 14-16, and 19 Rejected as Anticipated by Linzenkirc

Applicant argues the abstract of Linzenkirc does not teach a component for converting the revolution of the electric motor (9, 9') into linear motion of the valve spindle (4). Referring to the abstract, Linzenkirc discloses "[I]nside the top are two electric motors (9) in parallel with their spindles connected by equalising drives (10) to toothed spindles (11) meshing with a common gearwheel (12) on a spindle (14) with threads engaging a nut (13) on top of the valve spindle. A person would reference the English abstract in combination with Figure 1 of Linzenkirc to find the components described in the Final Office Action.

Applicant argues the abstract of Linzenkirc does not disclose the electric motors (9,9') as being synchronized. This argument is not persuasive because Figure 1 and the abstract disclose the motors being connected by a common gearwheel (12), wherein the gearing would inherently synchronize the motors.

(C) Claims 3 and 7 Rejected as Obvious over Linzenkirc in view of Vyskocil

Applicant argues the combination of teachings of Linzenkirc and Vyskocil do not teach the features of claims 3 and 7. This argument is not understood because Linzenkirc teaches a gear arrangement for actuating a valve spindle and the Vyskocil teaches an alternative gear arrangement having a worm gear for actuating a valve spindle. It would have been obvious to one of ordinary skill in the art to configure the gearing device of Linzenkirc with a worm arrangement having a drive shaft arranged perpendicular to the longitudinal direction of the operating element, as taught by Vyskocil, motivation being to provide a gear device having a predetermined speed reduction.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Linzenkirc teaches actuating a valve using gearing and Vyskocil teaches actuating a valve using a worm gear arrangement.

(D) Claim 13 Rejected as Obvious over Linzenkirc

Applicant argues the abstract of Linzenkirc does not recite a revolution/linear motion converter being arranged for converting the revolution of the driving motor into a linear motion of the operating element. As discussed above, the combination of the English abstract, the Figures, and the International Search Report of Linzenkirc teach the claimed revolution/linear motion converter.

The prior art to Linzenkirc alone or in combination with Vyskocil teach each and every feature of the claims. Accordingly, the claims are anticipated by the prior art and should stand rejected as described in the Final Office Action.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William C. Joyce/

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